

REMARKS

In the Office Action mailed on October 31, 2006, the Examiner withdrew the finality of the previous Office Action; rejected claims 1, 2, 4, 5, 7, 120, 121, 124, 126, 127, 130-132, 134, 135, 137, 138, 140, 143-145, 147-155, 157, and 164-167 under 35 U.S.C. § 102(b) as allegedly being anticipated by Codling et al. (U.S. Patent No. 3,378,010); rejected claims 6, 133, 146, and 156 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Codling et al. in view of Porter (U.S. Patent No. 5,676,676); and rejected claims 129 and 142 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Codling et al. in view of Yoon (U.S. Patent No. 5,695,505).

By this Amendment, Applicants amend claims 1, 120, 135, and 148 and cancel claims 6, 133, 146, and 156 without prejudice or disclaimer. Claims 1, 120, 135, and 148 have been amended to substantially include, among other things, the subject matter of claims 6, 133, 146, and 156, respectively. Claims 1, 2, 4, 5, 7, 120, 121, 124, 126, 127, 129-132, 134, 135, 137, 138, 140, 142-145, 147-155, 157, and 164-167 are currently pending. Of these, claims 1, 120, 135, and 148 are independent.

Each of independent claims 1, 120, 135, and 148 recites, among other things, a device (e.g., a clip) that comprises first and second arms that are "comprised of a bioabsorbable material such that the first and second arms are capable of disintegrating in a body." Since independent claims 1, 120, 135, and 148 have incorporated the recitations of now-canceled dependent claims 6, 133, 146, and 156, respectively, and the Examiner did not apply the Section 102(b) rejection to those dependent claims, the Section 102(b) rejection is moot.

Insofar as the rejection of now-canceled dependent claims 6, 133, 146, and 156 under Section 103(a) over Codling et al. in view of Porter is relevant to amended claims 1, 120, 135, and 148, Applicants respectfully disagree with the assertions in that rejection. In rejecting claims 6, 133, 146, and 156, the Examiner states that Codling et al. “is silent with regards to the clip device comprising bioabsorbable material.” The Examiner relies on Porter as showing a clip having bioabsorbable material and argues that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device of Codling [et al.] with bioabsorbable materials because it would allow the clip to be dissolved within the body and prevent the need of a follow-up surgery to remove the clip.” See Office Action at page 4.

Codling et al. discloses a clip with jaws 100 and 120¹, which the Examiner contends correspond to the claimed first and second arms. Even assuming that jaws 100 and 120 can be interpreted to correspond to the claimed arms, which Applicants do not concede, Codling et al. does not disclose or suggest arms that are comprised of a bioabsorbable material such that they can disintegrate in a body. The Office Action recognizes this deficiency in Codling et al.

Moreover, the modification of the arms as proposed in the Office Action would *not* have been obvious because Codling et al. *teaches away from* arms comprised of a bioabsorbable material such that they can disintegrate in a body. According to the M.P.E.P. and Federal Circuit case law, prior art that teaches away from an aspect of the claimed invention cannot be combined with a reference teaching that aspect to render

¹ The Examiner indicated that “the clip [has] a first arm 110 and a second arm 120,” but Applicants understand that the Examiner intended to refer to jaws 100 and 120, as indicated in Fig. 5 of Codling et al. Reference number 110 refers to the flanges on the jaw, rather than the jaw itself. See, for instance, Codling et al. at column 6, line 7.

the claimed invention obvious. See M.P.E.P. § 2141.02(VI) citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

Codling et al. first describes prior attempts to avoid the problems of removal of clips from the body. The reference teaches that “clips capable of dissolution or absorption in the body” cause serious problems with tissue irritation and uneven erosion of jaw surfaces. See Codling et al. at column 1, lines 42-56. Because of this uneven erosion of jaw surfaces, “jaw pressure on the tissues starts to decrease as soon as erosion begins and the decrease in specific pressure may well occur at different rates in different areas between the jaws.” Codling et al. at column 1, lines 52-56.

Codling et al. then states that an object of its invention “is to devise a surgical clip which incorporates relatively inert jaws which will be non-irritating to the tissues and which *will not erode or dissolve* appreciably during the required post-operative period in which the jaws are required to exert pressure on a given area.” Codling et al. at column 1, line 67 to column 2, line 2 (emphasis added). Codling et al. repeatedly states that the jaw surfaces of its clip therefore comprise a noble metal, specifically so that body fluids will not dissolve or erode the jaws. See, for example, Codling et al. at column 2, lines 27-31; column 2, lines 52-58; column 3, lines 10-27; column 7, lines 36-41. Hence, Codling et al. clearly *teaches away from* first and second arms comprised of a bioabsorbable material such that the first and second arms are capable of disintegrating in a body.

Thus, amended claims 1, 120, 135, and 148 cannot be rendered obvious by Codling et al. in view of Porter. Even if Codling et al. and Porter, taken together, disclose the claimed clip, which Applicants do not concede, one of ordinary skill in the

art would not be motivated to modify Codling et al. with the teachings of Porter because Codling et al. teaches away from such modification. Therefore, amended independent claims 1, 120, 135, and 148 and their dependents are allowable over this combination of references.

Applicants respectfully traverse the Examiner's rejection of claims 129 and 142 under 35 U.S.C. § 103(a) over Codling et al. in view of Yoon. Even if the Examiner's allegations are true, and Applicants do not necessarily agree that they are, claims 129 and 142 are allowable at least due to their dependence upon claims 120 and 135, respectively.

For the above reasons, Applicants respectfully request that the Examiner withdraw rejections of all pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, and/or drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to an exemplary embodiment described in the specification or abstract and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

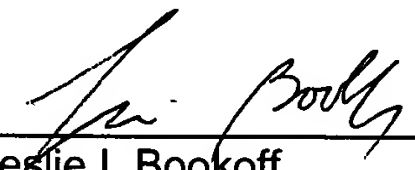
Please grant any extensions of time required to enter this Amendment and
charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 25, 2007

By: _____


Leslie I. Bookoff
Reg. No. 38,084